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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,104	02/25/2004	Teruhiko Tsuji	042125	8813
38834	7590	10/27/2005		
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,104

Applicant(s)

TSUJI, TERUHIKO

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02252004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it contains reference numbers that are not set of in parentheses, it is longer than 150 words and it is written in more than one paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Graham et al. 3,271,888. Graham et al. '888 discloses all the limitations of the claims including the following: a protecting tool 10 for a shoe; the tool comprising an overshoe type attaching member 32, 42 which is put on over a footwear in a state of wearing the footwear; a protecting member 24 having rigidity and attached to the attaching member so as to cover at least an instep portion (see Figure 1); the protecting member comprises a curved portion (covers metatarsals of the uses foot in the instep area) which is curved along at least a shape of the instep portion (see Figure 4); a leg portion 82 which comes into contact with the ground when the curved portion receives impact so that the curved portion is prevented from moving toward the instep portion in a state in which the curved portion is spaced from the instep portion (see col. 3, lines 8-14); the attaching member comprises holding means 32, 42 for holding the protecting member such that a lower

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end edge of the leg portion is located above the ground-contact surface except a case in which the protecting member receives an impact (see Figures 1 and 3); the holding means includes an engaging portion 34 provided between the attaching member and the protecting member; the engaging portion comprises a first engaging portion formed in front portions of the attaching member and the protecting member (holes for portions 34) and a second engaging portion 34 formed in rear portion of the attaching member and the protecting member and turnably engaging with the protecting member (rotates with respect to strap, see Figures 1 and 3); the first engaging portion comprises a holding projection (rivet 34) provided on one of the attaching member and the protecting member; a portion (hole for rivet) to be engaged provided on the other one of the attaching member and the protecting member; the second engaging portion comprises a holding shaft (rivet) provided on one of the attaching member and the protecting member; a mounting hole (hole for rivet 34 to pass through) on the other one of the attaching member and protecting member; the attaching member comprises an attachment bottom 50 which supports a bottom of the footwear and an attaching member body 60 which is made of resiliently deformable material and which urges the footwear so as to fix the footwear on the attachment; the protecting member is laterally symmetric with respect to a center in the widthwise direction thereof (see Figure 1)

4. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Wasser 2,344,069. Wasser '069 discloses all the limitations of the claims including the following: a protecting tool 10 for a shoe; the tool comprising an overshoe type attaching member 25, 30, 35 which is put on over a footwear in a state of wearing the footwear (see Figure 1); a protecting member 11 having rigidity and attached to the attaching member (see Figure 1, attached at 21) so

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as to cover at least an instep portion; the protecting member comprises a curved portion (see Figure 3, curved portion covers the metatarsals of the user's foot in the instep area) which is curved along at least a shape of the instep portion; a leg portion (sides where 4 are located) which comes into contact with the ground when the curved portion receives impact so that the curved portion is prevented from moving toward the instep portion in a state in which the curved portion is spaced from the instep portion (see col. 2, lines 6-10); the attaching member comprises holding means 30 for holding the protecting member such that a lower end edge of the leg portion is located above the ground-contact surface except a case in which the protecting member receives an impact (see Figure 1 and col. 2, lines 6-10); the holding means includes an engaging portion 30 provided between the attaching member and the protecting member; the engaging portion comprises a first engaging portion 29 formed in front portions of the attaching member and the protecting member and a second engaging portion 28 formed in rear portion of the attaching member and the protecting member and turnably engaging with the protecting member (see Figure 1); the first engaging portion comprises a holding projection 29 provided on one of the attaching member and the protecting member; a portion to be engaged 31 provided on the other one of the attaching member and the protecting member; the second engaging portion 28 comprises a holding shaft 21 provided on one of the attaching member and the protecting member; a mounting hole 28 on the other one of the attaching member and protecting member; the attaching member comprises an attachment bottom 27 which supports a bottom of the footwear and an attaching member body 30 which is made of resiliently deformable material and which urges the footwear so as to fix the footwear on the attachment; the protecting member is laterally symmetric with respect to a center in the widthwise direction thereof (see Figure 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the references as applied above in view of Official Notice. Either of the references as applied above discloses all the limitations of the claims except for the protecting member being made of synthetic resin. Official Notice is taken that the use of synthetic resin for a protector for a user's foot is old and well known in the art of shoe making because it allows the protector to be strong, light in weight and resilient. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the protector of either of the references as applied above out of synthetic resin to make it light in weight, durable, strong and resilient to rebound back after impact.

Conclusion

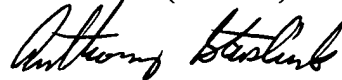
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS